UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,680	04/05/2001	Michael G. Coutts	8717.00	3504

26889   7590   08/05/2009

MICHAEL CHAN
NCR CORPORATION
1700 SOUTH PATTERSON BLVD
DAYTON, OH 45479-0001

EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
08/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1   UNITED STATES PATENT AND TRADEMARK OFFICE
2   _____
3
4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   Ex parte MICHAEL G. COUTTS and LEE G. DOVE
9   _____
10
11   Appeal 2009-000374
12   Application 09/826,680
13   Technology Center 3600
14   _____
15
16   Decided: August 5, 2009
17   _____
18
19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 BIBHU R. MOHANTY, *Administrative Patent Judges.*
21
22 FETTING, *Administrative Patent Judge.*
23
24
25
26   DECISION ON APPEAL

1   STATEMENT OF THE CASE
2

3   Michael G. Coutts and Lee G. Dove (Appellants) seek review under 35

4   U.S.C. § 134 of a final rejection of claims 16-32, the only claims pending in

5   the application on appeal.

6   We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)

7   (2002).

8
9   We AFFIRM-IN-PART.

10   The Appellants invented an ATM for displaying authorized

11   advertisements during a transaction. Specification 1:5-6.

12   An understanding of the invention can be derived from a reading of

13   exemplary claim 16, which is reproduced below [bracketed matter and some

14   paragraphing added].

15   16. An automated teller machine (ATM) for dispensing cash in
16   the form of paper money to an ATM customer conducting a
17   cash dispense transaction at the ATM and for displaying
18   advertisements for the ATM customer to view while the ATM
19   customer is conducting the cash dispense transaction at the
20   ATM, the ATM comprising:
21   [1] a cash dispenser
22   for dispensing cash to an ATM customer
23   when the customer is conducting a cash dispense
24   transaction at the ATM;
25   [2] an ATM display;
26   [3] means for accessing an advertisement database

1   to retrieve an authorized advertisement associated with

2   the ATM; and

3   [4] means for incorporating the retrieved advertisement in a

4   screen

5   for displaying on the ATM display

6   to allow the ATM customer to view the screen

7   while the ATM customer is conducting the cash dispense

8   transaction at the ATM.

9

10   This appeal arises from the Examiner's Final Rejection, mailed July 13,

11 2006. The Appellants filed an Appeal Brief in support of the appeal on

12 April 23, 2007. An Examiner's Answer to the Appeal Brief was mailed on

13 April 11, 2008. A Reply Brief was filed on June 16, 2008.

14   PRIOR ART

15   The Examiner relies upon the following prior art:

Drummond[1]	US 60/149,765	Aug. 19, 1999
Gupta	US 6,487,538 B1	Nov. 26, 2002
Drummond	US 2005/0216888 A1	Sep. 29, 2005

16   REJECTIONS

17   Claims 16-24, 26-28, and 30-32 stand rejected under 35 U.S.C. § 102(b)

18 as anticipated by Drummond.

19   Claims 25 and 29 stand rejected under 35 U.S.C. § 103(a) as

20 unpatentable over Drummond and Gupta.

---

[1] This is the provisional application upon which the published application relies for the benefit of priority. It is unpublished but is publicly accessible. *See* discussion *infra*.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 16-24, 26-28, and 30-32 under 35 U.S.C. § 102(b) as anticipated by Drummond.

  - This issue turns on whether Drummond is entitled to the filing date of its provisional application, and whether Drummond describes various limitations in the claims.

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 25 and 29 under 35 U.S.C. § 103(a) as unpatentable over Drummond and Gupta.

  This issue turns on whether Drummond and Gupta describe various limitations and whether one of ordinary skill would have applied the references together.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of "allocation time."

Facts Related to Appellants' Disclosure

02. The Specification discloses that, "allocation times may[, for example,] include: "'dead time' during a transaction; a period

prior to a user entering his/her card; or such like". Specification 3:24-26.

03. One implementation of advertisement screening is for advertisements to be screened after being added to a database and accessed after being screened. Specification 5:24-25.

Drummond

04. Drummond is directed to a banking machine connected to a computer, a sheet dispenser mechanism, card reader and other physical transaction function devices in the banking machine. The computer includes software for handling HTML or other documents to send and receive HTML documents and HTTP messages. Drummond ¶ 0030. Provisional Application 7:1-18.

05. Drummond describes software used in the computer, which includes a browser operative to process documents and cause a computer to produce outputs. Drummond ¶ 0074. Provisional Application 16:9-15.

06. Drummond describes using the document(s) or record(s) which contain the customer data to dynamically generate a document for the particular customer in the particular circumstances to reduce the effort associated with developing in advance a personal visual page or document for each customer. This may involve including various types or categories of user information in the document(s) or record(s) that pertain to a particular customer, such as gender, related persons, account types, permitted transactions, customer preferences, customer interests, account balances, previous offers

declined or accepted and other information. This customer
information can be used to generate an appropriate document for
the browser to access based on the customer "profile" and the
transaction devices present in the particular machine, information
on which is stored in a data store in the machine or elsewhere in
the system, as well as other factors such as the day of the week
and time of day based on a system clock. Drummond ¶ 0113-14.
Provisional Application 32:1-16.

07.   The profile applet builds and accesses transaction documents
and may offer incentives, premiums, additional transaction
options or advertising information selectively to customers.
Drummond ¶ 0115. Provisional Application 32:17 – 33:3.

08.   Drummond describes causing the ATM computer to access
other documents in other servers, such as stock market data, and
selectively provide it to customers. The profile applet may
generate documents to produce initial display screens of a
transaction sequence and may also operate to provide information
or access or produce documents which generate visual outputs to
the customer at other points in a transaction or between
transactions. This may further be used in systems in which the
operator of the machine is able to sell paid advertising to third
parties and then access the HTTP records such as HTML files
corresponding to those third parties' products or services. Such
accessing may be done based on a periodic or other basis, but may
be done effectively by selecting the HTTP record to access in
response to the profile of the particular customer. As later

1   described, advertising documents may be accessed from

2   advertising servers connected to the network. Advertising

3   materials may be delivered to customers from the machine at

4   various times during transactions, such as between steps

5   controlled by documents from the server operated by the

6   customer's institution. Advertising materials may be displayed

7   when transaction function devices, such as a sheet dispenser are

8   operated. The operator of the machine and/or a system in which

9   the machine is connected, may also require payment from

10   advertisers for presenting the advertising materials. Drummond ¶

11   0116. Provisional Application 33:4-20.

12   09.   Drummond describes using HTML documents to process an

13   ATM transaction between the browser and the home server. The

14   document returned from the home server may include advertising

15   or other information instead of or in addition to the customer

16   message. The document returned may also include an instruction

17   which causes the machine to access or generate another document.

18   These instructions may invoke methods in the profile applet which

19   depend on the properties associated with the customer, the

20   machine, the current time and/or other circumstances. This

21   enables accessing documents that provide promotional messages

22   such as advertising or other information to the customer while the

23   customer is waiting for the sheet dispenser or other transaction

24   function device in the machine to operate. Drummond ¶ 0121.

25   Provisional Application 35:5-12.

1　10. The home HTTP server may deliver documents selectively to

2　　　the ATMs. Examples of particularly tailored screens may include

3　　　bilingual messages in certain neighborhoods or information

4　　　concerning currency exchange at various ports of entry. The

5　　　material or messages could include advertising for various

6　　　products or services or other material targeted to particular

7　　　machine locations. The JAVA applets and JAVA script are loaded

8　　　from a central location providing selective software distribution in

9　　　the ATMs which may also be used to tailor the ATM to its

10　　environment by causing it to access documents which include

11　　material intended to be useful in that location, and which is not

12　　provided in documents delivered to at least some other machines

13　　in the system. Drummond ¶ 0088. Provisional Application 21:13-

14　　23.

15　11. These documents may be accessed from servers connected to

16　　the Internet. This enables operators of ATMs and other transaction

17　　machines to present advertising to customers, on a broad basis, or

18　　targeted to categories of customers or even targeted to individual

19　　customers on a segment of one basis.

20　　　"This could be advertising of the machine operator such as

21　　　a bank, or advertising pertaining to virtually any type of

22　　　goods or services. The advertising may also be selectively

23　　　presented based on the particular transaction device being

24　　　operated, the amount of funds involved or other

25　　　parameters. Access to advertising documents may be

26　　　tracked and payments made to the customer's institution,

1   the operator of the system and/or the owner of the

2   machine, by the entity associated with the advertising

3   materials presented to the customers."

4   Drummond ¶ 0121. Provisional Application 35:12 – 36:2.

5 12.   Drummond describes how the data and applets used may be

6   retrieved from a database in a remote server. Drummond ¶ 0127.

7   Provisional Application 38:17-20.

8 13.   Drummond describes use of a device server to monitor

9   transactions for security. Drummond ¶ 0034. Provisional

10   Application 8:11-18.

11 14.   The Examiner has shown that all of the passages relied on in

12   Drummond are fully described with essential duplication in the

13   provisional application 60/149,765 (Ans. 10) and that there was a

14   proper chain of applications for the benefit. Answer 8-9.

15 *Facts Related To The Level Of Skill In The Art*

16 15.   Neither the Examiner nor the Appellants have addressed the

17   level of ordinary skill in the pertinent arts of systems analysis and

18   programming, on line advertising systems, advertising and

19   promotion design, and database system design. We will therefore

20   consider the cited prior art as representative of the level of

21   ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350,

22   1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the

23   level of skill in the art does not give rise to reversible error 'where

24   the prior art itself reflects an appropriate level and a need for

1   testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v.*

2   *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

3   *Facts Related To Secondary Considerations*

4   16.   There is no evidence on record of secondary considerations of

5   non-obviousness for our consideration.

6

7   PRINCIPLES OF LAW

8   *Claim Construction*

9   During examination of a patent application, pending claims are

10   given their broadest reasonable construction consistent with the

11   specification. *In re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969);

12   *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369. (Fed. Cir.

13   2004).

14   Limitations appearing in the specification but not recited in the claim are

15   not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,

16   1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the

17   specification" without importing limitations from the specification into the

18   claims unnecessarily). S*ee also Tex. Digital,* 308 F.3d 1200, 1204-05.

19   Although a patent applicant is entitled to be his or her own lexicographer

20   of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*

21   *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing

22   such definitions in the specification with sufficient clarity to provide a

23   person of ordinary skill in the art with clear and precise notice of the

24   meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480

25   (Fed. Cir. 1994) (although an inventor is free to define the specific terms

1   used to describe the invention, this must be done with reasonable clarity,

2   deliberateness, and precision; where an inventor chooses to give terms

3   uncommon meanings, the inventor must set out any uncommon definition in

4   some manner within the patent disclosure so as to give one of ordinary skill

5   in the art notice of the change).

6   *Anticipation*

7   "A claim is anticipated only if each and every element as set forth in the

8   claim is found, either expressly or inherently described, in a single prior art

9   reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,

10 631 (Fed. Cir. 1987). "When a claim covers several structures or

11 compositions, either generically or as alternatives, the claim is deemed

12 anticipated if any of the structures or compositions within the scope of the

13 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.

14 Cir. 2001). "The identical invention must be shown in as complete detail as

15 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d

16 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by

17 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology

18 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

19 *Obviousness*
20   A claimed invention is unpatentable if the differences between it and

21 the prior art are "such that the subject matter as a whole would have been

22 obvious at the time the invention was made to a person having ordinary skill

23 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550

24 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13.(1966).

25   In *Graham*, the Court held that that the obviousness analysis is

26 bottomed on several basic factual inquiries: "[(1)] the scope and content of

1   the prior art are to be determined; [(2)] differences between the prior art and

2   the claims at issue are to be ascertained; and [(3)] the level of ordinary skill

3   in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at

4   406. "The combination of familiar elements according to known methods is

5   likely to be obvious when it does no more than yield predictable results." *Id.*

6   at 416.

7   ANALYSIS

8   *Claims 16-24, 26-28, and 30-32 rejected under 35 U.S.C. § 102(b) as*

9   *anticipated by Drummond.*

10 *Claims 16, 17, 19, 28, 31, and 32*

11   The Appellants argue independent claim 16 and presents no separate

12 arguments for independent claims 19 and 28, and dependent claims 17, 31,

13 and 32. Accordingly, we treat these claims as a group, and we select claim

14 16 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

15   The Appellants contend that the Examiner has not shown that

16 Drummond is prior art, by showing that it met the requirements for the

17 benefit of the provisional application filing date. Appeal Brief 20-21. The

18 Examiner has provided this showing in the Answer. FF 14.

19   The Appellants spend a great deal of their Appeal and Reply Briefs

20 contending they have been unable to obtain a copy of the provisional

21 application. We have verified that a copy of the provisional application is

22 available to the public on Public PAIR on the U.S. Patent & Trademark

23 Office's web site.[2]

24

---

[2] http://portal.uspto.gov/external/portal/pair

1

Claim 18

Claim 18 contains the limitation that the ATM program is operable to allocate screen space to the Web browser in accordance with predefined allocation times. The Appellants contend that Drummond fails to describe the browser and use allocation times. Appeal Brief 21-22. We disagree. Drummond describes a browser used in the ATM's computer. FF 05. Drummond also describes using its applet to generate documents such as advertising on the browser between steps with a transaction, between transactions or when physical paper sheets are being dispensed (FF 08) or while the customer is waiting for some device to complete its operation. (FF 09). The Specification does not define "allocation time" (FF 01), but does disclose that examples include transaction dead time (FF 02). Dead time is, generally, time that a customer is waiting. So, time between transactions and time waiting for a device to operate which Drummond uses for displaying advertisements on a browser would be examples of allocating screen space to the Web browser in accordance with predefined allocation times.

Claim 20

As with claim 16, the Appellants contend that the Examiner has not shown that Drummond is prior art by showing that it met the requirements for the benefit of the provisional application filing date. Appeal Brief 22-23. The Examiner has provided this showing in the Answer. FF 14.

Claim 21

Claim 21 requires logging the number of times the advertisement database has been accessed by each ATM and applying a charge to each

1 advertisement based on the number of accesses. The Appellants contend

2 that Drummond fails to describe an advertising database or applying a

3 charge to each advertisement based on the number of accesses. Appeal Brief

4 23-24.

5   We disagree. Drummond explicitly describes the use of a database

6 server to store all the data, including advertising data, in a database. FF 12.

7 Drummond also describes tracking access to advertisements and paying the

8 party presenting the advertisement, accordingly. FF 11. The Appellants

9 contend this passage only refers to payment. However the sentence in which

10 payment is described begins with tracking access to the advertising

11 documents.

12   Access to advertising documents may be tracked and payments made to
13 the customer's institution, the operator of the system and/or the owner of the
14 machine, by the entity associated with the advertising materials presented to
15 the customers.

16   Drummond ¶ 0121. The structure of the sentence clearly demonstrates

17 the nexus between accesses to the advertisements tracked and payment,

18 particularly in light of the notoriety of advertising revenue based on number

19 of views. Drummond ¶ 0121.

20 *Claims 22-24*

21   Claim 22 is independent and requires, "a server interconnected to the

22 ATM and for accessing the advertisement database in response to a request

23 from the ATM." Appeal Brief 24. The Appellants present no separate

24 arguments for dependent claims 23 and 24. *See* Appeal Brief. The

25 Appellants contend that Drummond does not describe such a server. Appeal

26 Brief 24-25. As we found with claim 21, *supra*, Drummond does describe

27 such a server. FF 12.

1

Claim 26

Claim 26 is independent and requires two servers, one to authorize cash transactions and one to retrieve advertisements. The Appellants contend that Drummond fails to describe both servers. Appeal Brief 25.

We disagree. As found *supra*, Drummond shows a database server for advertisements. FF 12. Drummond also shows use of a device server for transaction security, which would include cash transactions. FF 13.

Claim 27

Claim 27 is independent and requires screening an advertisement, transmitted from an ATM, and storing it after screening. The Appellants contend that Drummond fails to describe this. We agree with the Appellants.

The Examiner found that Drummond described this at ¶'s 0088, 0142, and 0151. Answer 14-15. ¶'s 0142 and 0151 describe generic security screening software, such as for a firewall or for avoiding sending data to an inappropriate address and have nothing to do with screening the advertisements. ¶ 0088 does describe screening the advertisements, but in the opposite direction from that claimed. Drummond screens advertisements in the database before sending them to an ATM, rather than screening advertisements from the ATM to a database as claimed. FF 10.

Claim 30

Claim 30 is independent and requires a means for screening advertisements. The Appellants contend that this means is not described by Drummond. Appeal Brief 27.

1   We disagree with the Appellants. As we found *supra* under claim 27,

2   Drummond screens advertisements in the database before sending them to

3   an ATM. Unlike claim 27, claim 30 simply requires a means for screening.

4   One disclosed implementation of advertisement screening is for

5   advertisements to be screened after being added to a database and accessed

6   after being screened. FF 03.

7   The Appellants also argue whether means, for applying display criteria

8   to advertisements and transmitting advertisements to ATM's, are described.

9   But because Drummond applies the screening at the time of the customer

10   presence, such viewing of screened data would necessitate applying display

11   criteria and transmission to the ATM. FF 10.

12

13   *Claims 25 and 29 rejected under 35 U.S.C. § 103(a) as unpatentable over*

14   *Drummond and Gupta.*

15   Both claims 25 and 29 recite a limitation of screening an advertisement

16   to determine whether it meets an acceptance criterion. Claim 29 screens

17   advertisements in a manner similar to the limitation in claim 27.

18   Accordingly, we do not sustain the rejection for the same reasons. Claim 25

19   is dependent from claim 22 and, like claim 30, does not specify the timing of

20   the screening. The Appellants argue that one cannot combine Gupta with

21   Drummond because doing so would change Drummond's operation or

22   render it inoperable. Appeal Brief 27-39. Most of the Appellants'

23   arguments are pertinent to claim 29, whose rejection we will not sustain for

24   the aforementioned reasons. The sole purpose the Examiner relied on Gupta

25   for with respect to claim 25 is an elaboration of the screening methodology.

26   Answer 6. Thus, the rejection of claim 25 does not rely on the portions of

Gupta that the Appellants argue would render Drummond inoperable or unfit. We will sustain the rejection of claim 25.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 16-24, 26, 28, and 30-32 under 35 U.S.C. § 102(b) as anticipated by Drummond.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 27 under 35 U.S.C. § 102(b) as anticipated by Drummond.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 29 under 35 U.S.C. § 103(a) as unpatentable over the Drummond and Gupta.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) as unpatentable over the Drummond and Gupta.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 16-24, 26, 28, and 30-32 under 35 U.S.C. § 102(b) as anticipated by Drummond is sustained.

- The rejection of claim 27 under 35 U.S.C. § 102(b) as anticipated by Drummond is not sustained.

- The rejection of claim 29 under 35 U.S.C. § 103(a) as unpatentable over Drummond and Gupta is not sustained.

1   •   The rejection of claim 25 under 35 U.S.C. § 103(a) as unpatentable

2   over Drummond and Gupta is sustained.

3   No time period for taking any subsequent action in connection with this

4 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

5

6 <u>AFFIRMED-IN-PART</u>

7

8 __/mev

9 MICHAEL CHAN
10 NCR CORPORATION
11 1700 SOUTH PATTERSON BLVD
12 DAYTON OH 45479-0001

13
14
15
16